UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,722	05/23/2001	John R. Martin	10527US16	2165

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EXAMINER
DIXON, THOMAS A

ART UNIT	PAPER NUMBER
3628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>30 January 2007</u>.
2a) ☐ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>16, 17 and 20-31</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>16, 17 and 20-31</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>1/30/07</u>.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   The IDS filed 1/30/07 has been considered, an updated search revealed the

Smith et al (6,601, 159) reference which discloses the previously allowed feature, the

allowability is withdrawn.

2.   The Terminal Disclaimer filed on 2/25/03 is acceptable.

Specification

3.   The specification is objected to as it does not contain the priority of application

07/864,7077 as a CIP of application 07/538,981 in it's first sentence.

Priority

4.   The disclosure of the prior-filed CIP application, Application No. 07/5338,981,

filed 6/15/1990, fails to provide adequate support or enablement in the manner provided

by the first paragraph of 35 U.S.C. 112 for the attract mode in one or more claims of this

application.

Therefore, the priority date for the previously allowable feature is seen to be

07/846,707, filed 3/06/1998 and the allowability is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 16-17, 20, 22-23, 25-26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Castille (5,497,502) in view of Cohen (4,949,187) in view of Smith et

al (6,601,150).

As per Claim 16.
Castille ('502) discloses:
a communication interface for receiving the compressed digital song data and the
song identity data, see figure 1 (13) and column 5, lines 1-5;
a data storage unit for storing, see column 5, lines 28-29, images and associated
digital song data, see column 1, lines 17-29,
a display for showing, to a prospective user of the computer jukebox, information
identifying the songs for which digital song data is stored in the storage data unit and
that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);
selection keys responsive to a selection of a song to be played on the computer
jukebox from the song identity information displayed on the display, the selection keys
including a signal output representing activation of the selection keys, see column 5,
lines 1-25 and figure 1 (15);
at least one audio speaker, see figure 1 (17);
a processor connected to a memory, the memory including a decompression
algorithm for decompressing compressed digital song data, see column 5, lines 6-10;
causing the processor, in response to the signal output, to access and process
digital song data received from the data storage unit so that the accessed digital song
data corresponds to the song selected by the selection keys, see column 5, lines 1-5;
causing the processor to decompress the accessed digital song data and send
the digital song data to the digital to analog computer so that the song selected is
played on the computer jukebox as a result of the corresponding stored song digital
data being and converted by the processor and the digital to analog converter, see
column 5, lines 6-10; and
Castille ('502) discloses the storage of software, see column 5, lines 28-29, but
does not specifically disclose the storage of the received compressed digital song data
and the received song identity data in the data storage unit.
Cohen ('187) teaches transmitting audio disks and updating an inventory list in a
remote computer, see column 5, lines 1–6.
Therefore, it would have been obvious to one of ordinary skill in the art, at the
time the invention was made to cause the processor to respond to compressed digital
song data and to song identity data which may be received by the communication
interface of the computer jukebox, to control the storage of the received compressed
digital song data and the received song identity data in the data storage unit, as taught
by Cohen ('187) to create an updated library of songs stored in the computer jukebox.
Castille ('502) does not disclose a compressing and decompressing song data or
a user attract mode wherein song associated images are shown.

Smith et al ('159) teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per Claim 17.
Castille ('502) does not specifically disclose:
instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor.

Cohen ('187) teaches instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, see column 5, lines 2-7, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor, see column 4, lines 26-29 for the benefit of providing users with convenient access to videos and ensure proper royalty payments.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the updated list of songs and store song usage data as taught by Cohen ('187) for the benefit of providing users with convenient access to videos and ensure proper royalty payments.

As per Claim 20.
Castille ('502) further discloses communication interface is telecommunication and further the storage of file identity data, see column 4, line 62 – column 5, line 29.

As per Claim 22.
Castille ('502) discloses:
a plurality of computer jukeboxes, capable of playing songs selected by users of the jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox, see figure 1 (15) and column 4, lines 1-11;
a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;
a data storage unit for storing, see column 5, lines 28-29;
a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);
selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys

including a signal output representing activation of the selection keys, see column 5, lines 1-25 and figure 1 (15);

at least one audio speaker, see figure 1 (17);

a processor connected to a memory, the memory including digital song data, see column 5, lines 6-10;

a digital to analog converter coupled between the processor and the audio speaker to convert digital song data to an analog signal coupled to the speaker, see figure 1 (47);

causing the processor, in response to the signal output, to access and process digital song data received from the data storage unit so that the accessed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

causing the processor to send the digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored song digital data being and converted by the processor and the digital to analog converter, see column 5, lines 6-10; and

Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit and a management station for updating the library of songs in each of the plurality of jukeboxes.

Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1–6, from a management station, see figure 4 (36) with communication interface (58), processor (36), storing digital song data (12, 14, 16, 18, 20, 22, 24, 26), data compressor (58) and transmitter (58) and column 1, lines 46-61.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox from a management station, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

Castille ('502) does not disclose a compressing and decompressing song data or a user attract mode wherein song associated images are shown.

Smith et al ('159) teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per Claims 23.
Castille ('502) further discloses bi-directional communications, see figure 1 (2).

As per Claims 25.
Castille ('502) does not specifically disclose the display of the updated list.
Cohen ('187) teaches instructions causing the processor to display the updated library of songs, see column 5, lines 2-7 for the benefit of providing users with convenient access to videos.
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the updated list of songs as taught by Cohen ('187) for the benefit of providing users with convenient access to videos.

As per Claims 26.
Castille ('502) does not specifically disclose the storage of usage data.
Cohen ('187) teaches instructions causing the processor to store usage data, see column 4, lines 26-29 for the benefit of ensuring proper royalty payments.
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to store usage data as taught by Cohen ('187) for the benefit of ensuring proper royalty payments.

6.   Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castille

(5,497,502) in view of Cohen (4,949,187) in view of Smith et al (6,601,150) further in

view of Verduin et al (4,667,802).

As per Claim 27.
Castille ('502) discloses:
a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;
a data storage unit for storing, see column 5, lines 28-29;
a display for showing, to a prospective user, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);
a processor and a memory, the memory, see column 5, lines 6-10; and instructions:
causing the processor, in response to the signal output, to access and process song data received from the data storage unit so that the accessed song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;
causing the processor send the digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored song digital data being and converted by the processor, see column 5, lines 6-10; and
Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit and a management station for updating the library of songs in each of the plurality of jukeboxes.

Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1–6, from a management station, see figure 4 (36) with communication interface (58), processor (36), storing digital song data (12, 14, 16, 18, 20, 22, 24, 26), data compressor (58) and transmitter (58) and column 1, lines 46-61.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox from a management station, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

Castille ('502) does not disclose a compressing and decompressing song data or a user attract mode wherein song associated images are shown.

Smith et al ('159) teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

Castille ('502) does not disclose a money intake device or a user attract mode wherein song associated images are shown.

Verdun ('802) teaches a money intake device, see figure 1 (32), an attract mode displaying selected graphics when no selection is playing, column 1, lines 47-49, for the benefit of attracting customers and taking their money.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display song associated images and have a money intake device as taught by Verdun to attract users to the device and taking their money.

7.   Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Castille (5,497,502) in view of Smith et al (6,601,150)

As per Claim 28.
Castille ('502) discloses:
a communication interface for receiving the compressed digital song data and the song identity data, see column 3, lines 13-18 and column 4, lines 1-24;
a processor having a memory connected thereto, the memory including digital song data, see column 3, lines 19-24.
Castille ('502) does not disclose compressing and decompressing song or graphics data or an attract mode.

Smith et al ('159) teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per Claim 29.

Castille ('502) discloses:

a processor and a memory, see column 3, lines 13-24 and column 4, lines and

Castille et al does not disclose decompressing song or graphics data or an attract mode.

Smith et al ('159) teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per claim 30.

Castille ('502) does not disclose a user attract mode wherein song associated images are shown when no song is playing.

Smith et al ('159) teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

As per claim 31.

Castille ('502) does not disclose a user attract mode wherein song associated images are shown when no song is playing.

Smith et al ('159) teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decompress song associated graphics for the benefit of more efficiently using available storage capacity and have an attract mode to increase machine usage.

8.   Claims 29-30 are rejected under 35 U.S.C. 103(a) as being anticipated by Stern

et al (5,084,768) in view of Smith et al (6,601,159).

     As per Claim 29.
     Stern et al (5,084,761) discloses:
     a processor and a memory, see figure 8 (14) and a display (34) and
     generating a user attract mode in which song associated graphics are shown on
said display when no song is playing on the computer jukebox, see column 6, lines 35-
58.
     Stern does not disclose decompressing song or graphics data.
     Smith et al ('159) teaches compressing and decompressing video and audio data
to more efficiently use available storage capacity.
     Therefore, it would have been obvious to one of ordinary skill in the art at the
time the invention was made to decompress song associated graphics for the benefit of
more efficiently using available storage capacity.

     As per Claim 30.
     Stern et al (5,084,761) discloses generating a user attract mode in which song
associated graphics are shown on said display when no song is playing on the
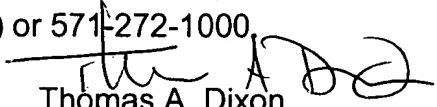computer jukebox, see column 6, lines 35-58.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thomas A. Dixon whose telephone number is (571)

272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas A. Dixon
Primary Examiner
Art Unit 3628

February 07